

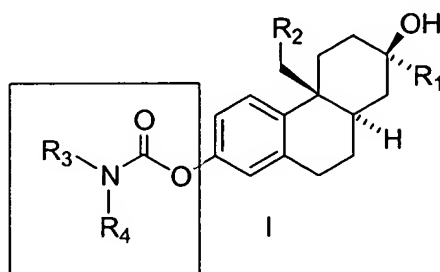
**REMARKS**

Claims 1-6, 12, 13, 18, 27, and 29 are currently pending and stand rejected under 35 U.S.C. 102 and 103. Claim 27 has been amended to include proper Markush language.

**I. 35 U.S.C. §102 rejections: *Claims 1-6, 12, 13, 18, 27, 24, and 29 are novel in view of Dow et. Al***

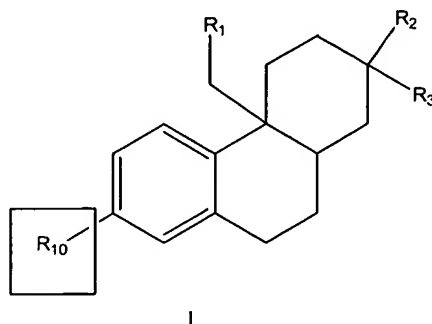
Reconsideration is respectfully requested of the rejection under 35 U.S.C. 102 of claims 1-6, 12, 13, 18, 27, 24, and 29 in view of Dow et al. (U.S. Patent 6,380,233)

Claim 1 is directed to compounds and their pharmaceutically acceptable salts of Formula I having the following structure:



wherein  $R_1$ ,  $R_2$ ,  $R_3$ , and  $R_4$  are as defined in the specification.

Claim 1 exemplifies compounds disclosed in Dow et al. Claim 1 is a compound having the formula:



wherein  $R_1$ ,  $R_2$ , and  $R_3$  are as defined in Dow et al.

In general, the Dow  $R_{10}$  moiety aligns with the  $-\text{O}(\text{CO})\text{NR}_3\text{R}_4$  moiety of present claim 1 (as indicated above via the boxes). According to claim 1 of Dow,  $R_{10}$  is  $-\text{C}(\text{O})-\text{NH}-\text{Z}-\text{het}$ . This requires the moiety connecting the radical to the benzene ring to be a **carbonyl**. Claim 1 of the present application, on

the other hand, requires an **oxygen linkage** connecting the corresponding moiety to the benzene ring. Thus, Dow does not describe a substituent corresponding to the  $-\text{O}(\text{CO})\text{NR}_3\text{R}_4$  moiety of claim 1.

The Office, however, asserts that compounds disclosed in columns 90-91 of Dow et al. anticipate claim 1. This is not correct. Of the 18 compounds disclosed in columns 90-91, 11 of them are recited in either claim 8 or 9. Claims 8 and 9, like claim 1, require  $\text{R}_{10}$  to be  $-\text{C}(\text{O})\text{-NH-Z-het}$ . Moreover, of the compounds disclosed in columns 90-91 that are not recited in claims 8 or 9, none have the substituent  $-\text{O}(\text{CO})\text{NR}_3\text{R}_4$  at the  $\text{R}_{10}$  position, as required by claim 1 of the present application.

As illustrated by this rough alignment between the substituents disclosed by Dow and those required in claim 1, the particular combination of substituents on the three ring structures, and in particular, on the benzene ring in claim 1, is not disclosed by Dow. Specifically, Dow does not disclose any substituent that corresponds to the  $-\text{O}(\text{CO})\text{NR}_3\text{R}_4$  moiety of claim 1 when  $\text{R}_1$ ,  $\text{R}_2$ ,  $\text{R}_3$ , and  $\text{R}_4$  are as recited in claim 1. Dow thus fails to disclose every element of claim 1, and therefore, claim 1 is novel in view of Dow. For the same reasons, claims 2-6, 12, 13, 18, 27, 24, and 29, which recite all of the claim 1 elements, are novel in view of Dow.

**II. The Cited Art is not Available to Support a Rejection of Claims 1-6, 12, 13, 18, 27, 24, and 29 under 35 U.S.C. § 103(a)**

In order to qualify as prior art to support a §103(a) rejection, each reference cited must qualify as prior art under 35 U.S.C. § 102.<sup>20</sup> According to the Office, Dow et al. qualify as prior art under § 102(e).

Effective November 29, 1999, 35 U.S.C. § 103(c) provides that subject matter which qualifies under 35 U.S.C. § 102(e) **is not** to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. § 103, provided the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Both the instant application and

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<sup>20</sup>See MPEP § 2144(II)(A)(1).

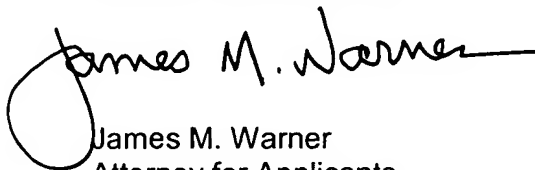
the Dow et al. patent have been assigned to Pfizer.<sup>21</sup> In light of this common assignment, Dow et al. are unavailable to support a rejection of claims 1-6, 12, 13, 18, 27, 24, and 29 under 35 U.S.C. §103.

Accordingly, the rejection of claims 1-6, 12, 13, 18, 27, 24, and 29 under 35 U.S.C. § 103(a) as obvious over Dow et al. is improper.

### III. Conclusion

In light of the foregoing, Applicants request withdrawal of the claim rejections, and solicit an allowance of the claims. The examiner is invited to contact the undersigned attorney should any issues remain unresolved.

Respectfully submitted,

A handwritten signature in black ink that reads "James M. Warner". The signature is fluid and cursive, with a large, stylized initial "J" that loops around the first part of the name.

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<sup>21</sup>Applicants can submit copies of the assignment documents the Dow patent and the instant application upon request.